



7 / *Provisional*
Wm. J. Hirsch
4/2/02
PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants : Burns, et al.)
Ser. No. : 09/541,180)
Filed : April 3, 2000)
For : Coinless Slot Machine)
System and Method)
Art Unit : 3713)
Examiner : Jessica Harrison)

I hereby certify that this paper is being deposited with the United States Postal Service as First Class Mail, postage prepaid, in an envelope addressed to:

Commissioner for Patents
Washington, D.C. 20231, on this date:

Date: June 14, 2002

Martin J. Hirsch

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Registration No. 32,237

INFORMATION DISCLOSURE STATEMENT

Commissioner for Patents
Washington, D.C. 20231

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TECHNOLOGY CENTER R3700

Sir:

In accordance with the provisions of 37 C.F.R. §1.97, the documents identified on the enclosed PTO-1449 form are disclosed to the Examiner for consideration in connection with the present application. Copies of all documents, except those marked with an asterisk, are enclosed.¹ The parent of the present application issued as U.S. Patent No. 6,048,269. The '269 patent is assigned to MGM Grand, Inc. and is exclusively licensed to IGT, which is a wholly owned subsidiary of International Game Technology.

By a complaint for patent infringement and declaratory judgment dated January 22, 2002, Aristocrat Technologies, Inc. and other parties allege that International Game Technology and IGT infringed a number of patents and that a number of other patents,

¹ It is assumed that copies of the documents marked with an asterisk on the enclosed PTO-1449 form are already in the Patent Office file of the present application since those documents were listed on the PTO-892 enclosed with the Office Action mailed March 19, 2001 in connection with the present application. However, if the Examiner would like copies of any documents promptly forwarded to her, she is respectfully invited to contact the undersigned representative of Applicants.

including the '269 patent, "are invalid pursuant to 35 U.S.C. §§ 101, 102, 103 and/or 112." A copy of the complaint is enclosed and identified on the enclosed PTO-1449 form.

During the prosecution of the '269 patent, an information disclosure statement dated January 22, 1993 (referred to as the "1993 IDS") was filed. A copy of that information disclosure statement is enclosed. A number of statements about the prior art in that information disclosure statement appear to be either inaccurate or possibly misleading. The following remarks are provided to prevent any misplaced reliance on such statements.

Regarding U.S. Patent No. 4,322,612 to Lange, the 1993 IDS states that "The printer only provides a record of the transactions and not a coupon for further use in the wagering system." Although it is not clear which "printer" the above statement refers to, the Lange patent discloses a system having a number of self-service terminals D which can print a ticket which can be used later on in connection with a later horse race by inserting it into one of the self-service terminals. See, for example, column 8, line 59 through column 9, line 36.

Regarding U.S. Patent No. 4,373,726 to Churchill, et al., the 1993 IDS states that "nor is a printer for printing out a coupon disclosed." The Churchill, et al. patent does disclose a dispenser unit 12 having a printer 84 (Fig. 5) that prints cards. See, for example, column 4, lines 45-46, column 7, lines 7-11 and step 308 of Fig. 8.

Regarding U.S. Patent No. 4,494,197 to Troy, et al., the 1993 IDS states that "No means is disclosed for a conventional bar code reader or for a printer that prints coupons that may be accepted by the device." However, the Troy, et al. patent discloses bar code readers (see column 3, lines 9-16). With regard to the second part of the sentence quoted from the '93 IDS, see column 8, lines 50-63 regarding facsimile verification.

Regarding U.S. Patent No. 4,626,672 to Sapitowicz, et al., the 1993 IDS states that "Nor does it disclose a wagering system." However, the Sapitowicz, et al. patent clearly refers to wagering systems. See column 1, lines 12-24.

Regarding U.S. Patent No. 4,669,730 to Small, the 1993 IDS states "No wagering system is disclosed..." In that regard, see column 4, lines 40-43 of the Small patent, which states: "In certain states, the charges associated with using a debit card could be considered to constitute a lottery-type situation." The '93 IDS also states "The printer is used only to produce a record of the transaction and not to issue a payment coupon to the winner." However, column 5, lines 47-49 of the Small patent state that "a printed receipt is given to the user, which indicates the absence or presence of the winning correlation." See also column 8, lines 1-5 and 40-45.

Regarding U.S. Patent No. 4,880,237 to Kishishita, the 1993 IDS states "nor is there a means disclosed for printing a coupon for payment directly to the players." In that regard, the Kishishita patent discloses printing of cards C which are used by the players. See column 5, lines 1-17.

Regarding U.S. Patent No. 5,007,641 to Seidman, the 1993 IDS states "No means is disclosed for reading dollar bills or for printing coupons." However, the Seidman patent does disclose that coupons are printed. For example, column 1, lines 64-66 states "For example, coupons can be printed in a newspaper offering a discount on a specific item of merchandise in a store." See also column 2, lines 2-7 and 59-64 and column 4, lines 34-56, which states in part: "Token 30 of the first type are specially printed cards being (sic) the name of the establishment and also bearing a machine readable bar code 38" (col. 4, lines 36-38). See also column 6, lines 7-11.

Regarding U.S. Patent No. 5,135,224 to Yamamoto, et al, the 1993 IDS states "Also, no means for printing a coupon is disclosed." In that regard, at column 4, lines 60-68 the Yamamoto, et al. patent states: "When a player wishes to cease playing, he can do so by pressing the 'account' key 18, whereupon prize points so far scored are totalled and printed out on a slip of paper by the printer 62 in accordance with a predetermined form, and the prepaid card is returned to the player. The player may bring the slip to the prize exchange station to receive his prizes according to his earned points." See also column 2, lines 43-46 and column 3, lines 21-24.

In a reply dated May 23, 1994 to an Office Action mailed December 22, 1993 during prosecution of the '269 patent, a number of statements were made regarding U.S. Patent No. 4,322,612 to Lange discussed above. A copy of the reply is enclosed. The statements were made in a number of paragraphs on pages 4 and 5 of the reply, which are set forth below:

With respect to the rejection of claims 13-18, 21-31, and 34-37 under 35 U.S.C. §102(b) as being anticipated by Troy, et al....

* * * *

In contrast, the Troy, et al. patent discloses an automatic lottery system that prints a winning check or receipt for a future win or loss for each play of the game. (See Col. 2, lines 52-53; col. 6, Lines 5-11) The winning checks or receipts may not be used as credit for a player to replay the game. The Lang et al. patent teaches the printing of a winning ticket that is encoded in a non-negotiable form which could then be redeemed at a prescribed location. (Col. 12, lines 26-30) Thus, the check or receipt of Lang et al. must first be converted into currency or

other negotiable form of credit before it can be used to play the game again. There is no disclosure in Lang et al. for printing or otherwise generating a permanent record of a code corresponding to the monetary value of a player's credit that can serve the same function as currency in a conventional gaming device, such that the printed code representing the credits generated by the play of the game may be reused with the same machine, another machine of the same type, or with a conversion station capable of reading the code and converting it into currency.

It is believed that as now amended, claim 13 overcomes the rejection by the Examiner under 35 U.S.C. §102(b) over Lang et al....

Although the above excerpt purports to make statements regarding the "Lang et al." patent, it is believed that the references to the "Lang et al." patent were in the nature of typographical errors, and that such statements were intended to refer to the Troy, et al. patent and not U.S. Patent No. 4,322,612 to Lange. The basis for that belief is as follows: 1) the above excerpt was clearly responding to the rejection of claim 13 in view of the Troy, et al. patent, not the Lange patent; 2) the Office Action to which the reply was responding did not contain any rejection of the claims in view of the Lange patent; and 3) the reference to column 12, lines 26-30 only makes sense if it refers to the Troy, et al. patent; it does not make sense if applied to the Lange patent.

In a reply dated December 2, 1996 to an Office Action mailed during prosecution of the '269 patent, a number of statements regarding U.S. Patent No. 4,322,612 to Lange that were made in the 1993 IDS discussed above were repeated. A copy of the reply is enclosed. The statements were made in a paragraph on page 12 of the reply, which is set forth below along with the preceding paragraph of the reply:

With respect to the rejection of claim 66 under 35 U.S.C. §103 as being unpatentable over Lange, the language of claim 66 as now amended recites a change station for providing currency in exchange for credits generated by a game in response to the outcome of the game played and for providing credits in exchange for currency. The claimed invention is a two-way system for dispensing cash in exchange for a cash-out slip and for dispensing a cash out slip in exchange for currency.

In contrast, Lange discloses a wagering system where a record of the wager information is kept for each user and issues a printed report to the user of such information. Wagering information is entered at a separate money transaction station. No means for accepting or reading currency, credit cards, or bar

codes is disclosed. The printer only provides a record of the transactions and not a coupon for further use in the wagering system. No means for providing currency in exchange for credits generated by a game in response to the outcome of the game played and for providing credits in exchange for currency is taught, disclosed or suggested by Lange.

It should be noted that the above statements concerning the Lange patent were made in connection with then-pending claim 66, which was directed to a change station comprising an exchange system for providing currency in exchange for credits generated by a game in response to the outcome of the game played and for providing credits in exchange for currency.

To the extent that any of the above-noted statements and errors were inaccurate or misleading, Applicants' representatives hereby apologize to the Examiner and to the Office.

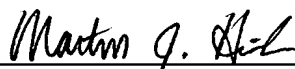
The submission of the documents identified on the enclosed PTO-1449 form is not an admission that they are prior art or relevant to the invention.

Respectfully submitted,

MARSHALL, GERSTEIN & BORUN

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By:



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